



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,821	12/14/2004	Shinji Inazawa	51023-025	8803
20277 7590 05/15/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
YANG, JIE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
05/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/517,821

Applicant(s)

INAZAWA ET AL.

Examiner

JIE YANG

Art Unit

1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

JY

Continuation on 11, does NOT place the application in condition for allowance because applicant argues that:

1) the Examiner has provided no factual basis for modifying the particle diameter corresponding to the particle diameter corresponding to the existing ratio of trivalent titanium ions and the tetravalent titanium ions, as required by claim 1. Senda does not describes or infer a solution containing both trivalent titanium ions and tetravalent ions. A fine metal powder having a particle diameter corresponding to the existing ratio of trivalent titanium ions and tetravalent titanium ions is not the final product of Senda. The present invention addresses the problems resulting from adding titanium trichloride to an aqueous solution (See, e.g. pg.6, line 16–pg.7, line 15 of the original filed specification).

2) if the particle diameter of the fine metal powder is determined only by the amount of the trivalent titanium ions, a graph showing the relationship between the ion concentration (%) of the trivalent titanium ions and the average particle diameter (nm) of the fine metal powders must have a linear shape, not a curve shape that is shown in Fig.1.

3, DE'865 and Senda do not disclose the same method of producing a fine metal powder as disclosed by the present inventors, and even if combined still fail to disclose or suggest the elements recited by claim 1. The only teaching of the process of forming a fine metal powder by subjecting a solution of tetravalent titanium ions to trivalent titanium ions and the claimed diameter is found in Applicant's disclosure.

In response, regarding the argument 1, applicant's arguments are against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, DE'865 in view of US'830 teaches the limitations of instant claim 1. As pointed out in the previous office action marked on 2/5/2008, Senda (US'830) teaches using different amount of Ti(III) solution to obtain different metal particles with diameters (examples 1-12 of the US'830). Senda clearly teaches the metal and non-metal compound or the complex is reduced by titanium trichloride (Col.2, lines 48049 of US'830). Therefore, the relationship between particle diameter and the ratio of Ti(III)/Ti(IV) is the same as relationship between particle diameter and the amount of Ti(III) in the solution.

Regarding the argument 2, the Examiner disagree with the Applicant's conclusion. First it has no evidence to prove the relationship between the ion concentration (%) of the trivalent titanium ions and the average particle diameter (nm) of the fine metal powders must have a linear shape. Second the Examiner notices only 5 data are shown in the graph 1 of the instant application, especially, below the 80% concentration of trivalent titanium ions 4 experiment data could also be treated as a linear curve if considering the error factors. Further evidences to support the Applicant's argument are needed.

Regarding the argument 3, DE'865 in view of US'830 teaches limitations as recited in the instant claims 1-5 and DE'865 in view of US'830, and further in view of US'581 teaches the limitation of claim 6, The motivations for combining these references can further refer to office actions marked 8/21/2007 and 2/5/2008.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

JY